

definition, be contained within "a message region." Also, the whereby clause having to do with positioning the card in the vicinity of the pet so that the pet may ingest the same, appeared to the undersigned as superfluous. The only other claims which remain pending in this application, dependent claims 18 and 19, are directed to multiple panels and are connected through some form of edible hinge.

Claims 1, 2 and 4 were rejected under 35 U.S.C. §103(a) over the Swiss Colony Christmas Gift Book in view of Stonoga et al, and an advertisement for Gaines dog biscuits which, as correctly pointed out by the Examiner, appeared in December of 1955. The undersigned apologizes for any previous misunderstanding about the date of this ad. Canceled claim 22, which included the limitation of a rawhide panel, was rejected under 35 U.S.C. §103(a) over the Gaines/Stonoga/Swiss Colony combination, and further in view of Spanier et al. Canceled claim 13, which included the limitation of printing with an edible ink, was rejected under 35 U.S.C. §103(a) over the Gaines/Stonoga/Swiss Colony combination, and further in view of Stewart.

By way of a very short review, the Swiss Colony Christmas Gift Book reference teaches personalized milk chocolate greeting cards containing messages such as "Seasons Greetings from Kathy and Steve," "Have a Heavenly Holiday from Mother," and so forth. Although animals such as horses and mice are depicted on these cards, the cards are not made from rawhide, and the designs are molded as opposed to imprinted with an ink. It would also be evident, in Applicant's opinion, that a purchaser would never expect that a pet would be an intended recipient, particularly because chocolate is not considered a pet food. Stonoga et al, U.S. Patent No. 4,203,516 resides in "a novelty greeting card directed to pet owners." (516 patent, col. 1, lines 6-7.) Although the card includes a cavity for the inclusion of a dog biscuit, the card itself is constructed of cardboard, plastic

and other materials which are inedible (col. 1, lines 47-50). The Gaines ad features differently shaped dog biscuits having molded therein the flavor of each biscuit such as "cheese," "liver," "milk," and so forth. The ad, and the biscuits, are unrelated to greeting cards, and it is apparent that the words relating to taste are directed to a human purchaser. With regard to the use of rawhide, Spanier et al sets forth a process for preparing rawhide containing pyrophosphate, such that the material is chewed or eaten by dogs, tarter accumulation on the teeth of the pet is reduced or prevented ('231 patent, Abstract). Although, admittedly, the process of Spanier et al can produce rawhide "in any shape," the examples given are strips, balls, curled pieces, and so forth, with no teaching or suggestion as to messages or greetings. As to the edible ink limitation (previous claim 13), Stewart teaches an edible film for decorating food stuffs, baked goods in particular, for human consumption. No mention is made of pets, pet greetings, or rawhide.

Applicant's argument that at least the remaining claims are nonobvious is two-fold. First, it is respectfully submitted that the cited references contain no teachings in support of their combination, such that the burden of establishing *prima facie* obviousness has not been met. Secondly, Applicant points to a growing list of objective, secondary indicia which favors the conclusion that Applicant's invention was not apparent to one of skill in the relevant art until Applicant himself claimed these combinations.

As the Examiner is well aware, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either from the references used for rejection or from knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine teachings. There must be a reasonable expectation of success, and the reference(s) must teach or suggest all limitations as claimed. (See MPEP §2143.03) In this case, it is respectfully submitted that there is

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no teaching from the cited references, or from knowledge generally available to one of skill in the *relevant art*, thereby defeating *prima facie* obviousness. One reason is that, in the opinion of Applicant, although the references used for the purpose of rejection each address edible substances in one form or another, there are, in fact, drawn from quite disparate fields of endeavor.

The Examiner's primary reference, the Swiss Colony Christmas Gift Book, discloses personalized chocolate Christmas cards for human consumption. It is respectfully submitted that, to one of ordinary skill in this art, namely, candy making for people, it would not obvious to modify the use of chocolate, and to substitute rawhide for an entirely different audience, namely, pets. Although the invention of Stonoga et al resides in a greeting card having a cavity to receive a dog biscuit, there is no teaching or suggestion that the card itself could be eaten by a pet, by constructing it from rawhide or other edible materials. And although the Gaines dog biscuits clearly intended for pet consumption, the messages have to do with informing the purchase as to the flavor, with no use of a message or graphics outside of the shape of the biscuit itself. In fact, even in combination, these references are incapable of rendering obvious to one of skill in Applicant's art the idea an edible greeting card containing an image and a message to give a purchaser the impression that a pet is the intended recipient of the greeting card. It is respectfully submitted that, although the Spanier et al patent concerns rawhide, the field of endeavor is actually chemical processing. Stewart, on the other hand, is directed to edible, peelable films, as opposed to inks, and is clearly limited to food stuffs for humans.

In addition to Applicant's claim that the burden of establishing a *prima facie* case of obviousness has not been met, it is well-settled that evidence arising out of the so-called "secondary considerations" must always, when present, be considered as part of an overall determination of

obviousness. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). Such objective indicia of non-obviousness may come in many forms, including commercial success, long-felt need, and copying by others.

In the case of Applicant's invention, the existence of infringing products presumably enjoying a certain degree of commercial success has already been made of record. Although Applicant has yet to introduce his own product, Applicant's disclosure was published in a corresponding PCT application in early 1997, and before the end of that year, products which read on Applicant's claims were introduced by Sergeants and Pet Greetings (Exhibits A and B to Applicant's granted Petition to Make Special on the grounds of infringing activities.) That Applicant's application was published, lends credence to the argument that Applicant's invention at least *could have* been copied by these competitive manufacturers. In terms of commercial success, although *Applicant* has not yet introduced a product, the commercial success of these competitors may reasonably be applied to a determination of nonobviousness on the grounds that these products are identical to at least one of the embodiments which Applicant now claims.

In addition to the objective evidence of non-obviousness already of record, Applicant would like to bring to the attention of the Examiner certain additional information just discovered by the Applicant. First, five individuals (three from Canada and two from the United States), who appear to be associated with Sergeant's have filed a PCT application claiming a rawhide greeting card, WO9913707. The application was published on March 25, 1999, and is available in the electronic database "espace" maintained by the European Patent Office, at URL <http://ep.espacenet.com>. The abstract and one drawing of the application are attached hereto as exhibit "A2."

Second, the Pet Greeting products are now widely available for sale on the world wide web. They are available in an electronic catalog <http://www.petgreetings.com>, as well as links from other websites, including the website of the ASPCA. (<http://www.aspca.org>), and an auction website, <http://www.ernet.com/ghost/cca2.htm>. ASPCA receives \$0.50 for each card sold by Pet Greetings, and this fact was confirmed by ASPCA's marketing department in a telephone communication placed to the company on October 14, 1999.

In addition, an electronic article of the Dog & Kennel magazine, dated February 16, 1999, includes the Pet Greetings rawhide greeting cards in its "hot dog files," and provides information in obtaining them. Another web story entitled "It's a dog's life: canine caterers barking up the right tree," posted on September 22, 1998, refers to "rawhide greeting cards printing with soy ink" as one of the "upscale" bakery and other edible gourmet items for dogs, at <http://www.k9treat.com/media/clt980923.html>. Copies of these web pages are attached as exhibit "B2".

Third, a web site maintained by the University of British Columbia, http://patscan.ubc.ca/funny/previous/bizarre_patents.htm, has a page devoted to "bizarre" patents or patent applications chosen every month from the PATSCAN Patent and Trademark Searching database. Applicant's Canadian application, CA 2,229,040, entitled EDIBLE GREETING CARDS, was featured as the "bizarre" patent application for the month of January 1999 (Appendix C2). Other "bizarre" patents include U.S. Patent No. 5,509,859 (LEASH WITH SOUND), which is described in the USPTO abstract as "[a] novelty item for creating the illusion of an imaginary pet including a hollow, elongated leash with a handle at one end and a collar and harness adjacent the other end," and U.S. Patent No. 5,713,081 (PANTYHOSE GARMENT WITH SPARE LEG

PORTION). Applicant respectfully submits that such inventions, being "bizarre," and unusual, would likewise be considered non-obvious to one of ordinary skill in the art at the time the invention was made.

Based upon the foregoing amendment and comments relating thereto, Applicant believes the claims which continue to be pending in this application are in condition for allowance. Questions regarding this application may be directed to the undersigned attorney at the telephone and facsimile numbers provided.

Dated: Nov. 5, 1999

Respectfully submitted,

By: _____

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